

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed April 19, 2007 rejected claims 1-9 and 20-30. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1-9 and 20-30 are pending. More specifically, claims 1, 21, and 30 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 1 and 30 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-2, 4-9 and 20-29 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). Claims 3 and 30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741). These rejections are respectfully traversed.

II. Rejections Under 35 U.S.C. §112

The Office Action rejects claims 1 and 30 under 35 U.S.C. §112, First Paragraph as allegedly failing to comply with the written description requirement. The Office Action alleges that “all non-text attachments automatically deleted” is no [sic] found in the specification, and is a negative limitation.” See *Office Action*, pg. 2. Applicant respectfully submits that this element is supported in at least one embodiment:

“The email device may provide for email attachments that are text or HTML, or other file types that can be converted into text. Other types of attachments (graphics, spreadsheets, pictures, etc.) cannot be viewed on the email device, and are deleted from any email message including such an attachment at the server.” *Specification*, pg. 12, lines 15-18.

For at least this reason, Applicant respectfully submits that the rejection of claims 1 and 30 should be withdrawn.

III. Rejections Under 35 U.S.C. §102(e)

A. Claims 1-2, 4-9 and 20

The Office Action rejects claims 1-2, 4-9 and 20 under 35 U.S.C. §102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection where not rendered moot by amendment.

Independent claim 1, as amended, recites:

1. A method of manipulating email messages with an email network appliance comprising:
 - receiving an email message with an email network appliance that can only provide the text of a message, ***the email message having had a determination made as to whether the attachment is text only and having had all attachments that are determined not to be text only automatically deleted such that the email message is text only***;
 - classifying the text only email message;
 - inserting the text only email message into a classification container; and
 - presenting the classification container in a classification display section.

(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that the amendments to claim 1 have rendered the rejection moot. Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that Tsai does not disclose, teach, or suggest at least **the email message having had a determination made as to whether the attachment is text only and having had all attachments that are determined not to be text only automatically deleted such that the email message is text only**. Even if, assuming for the sake of argument, *Tsai* teaches removal of attachments from the email message, it fails to teach determining whether the attachment is text only and automatically deleting all attachments that are determined not to be text only. In *Tsai*, an attachment may be removed for later access by the receiving device, but no determination is made as to whether the attachment is text only. “[R]ecipients of emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure.” See *Tsai*, col. 3, lines 12-14. In the instant claim, the user is only able to view text only emails. The system disclosed in *Tsai* has no such limitation. Therefore, *Tsai* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 2, 4-9 and 20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2, 4-9 and 20 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2, 4-9 and 20 are patentable over *Tsai*, the rejection to claims 2, 4-9 and 20 should be withdrawn and the claims allowed.

B. Claims 21-29

The Office Action rejects claims 21-29 under 35 U.S.C. §102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection where not rendered moot by amendment.

Independent claim 21, as amended, recites:

21. A system of manipulating email messages:
a server configured for receiving a plurality of email messages for a user,
for determining whether an attachment to the plurality of email messages is text only, and for automatically deleting all attachments that are determined not to be text only; and
a transmitter for transmitting the emails to a user for viewing on an email device that can only provide the text of the email message.
(Emphasis added).

Applicant respectfully submits that claim 21 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that the amendments to claim 21 have rendered the rejection moot. Applicant respectfully submits that independent claim 21, as amended, is allowable for at least the reason that *Tsai* does not disclose, teach, or suggest at least **a server configured for determining whether an attachment to the plurality of email messages is text only, and for automatically deleting all attachments that are determined not to be text only**. Even if, assuming for the sake of argument, *Tsai* teaches removal of attachments from the email message, it fails to teach determining whether the attachment is text only and automatically deleting all attachments that are determined not to be text only. In *Tsai*, an attachment may be removed for later access by the receiving device, but no determination is made as to whether the attachment is text only. “[R]ecipients of emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure.” See *Tsai*, col. 3, lines 12-14. In the instant claim, the user is only able to view text only emails. The system disclosed in *Tsai* has no such limitation. Therefore, *Tsai* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21, as amended, is allowable over the cited references of record, dependent claims 22-29 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that

dependent claims 22-29 contain all the features of independent claim 21. Therefore, since dependent claims 22-29 are patentable over *Tsai*, the rejection to claims 22-29 should be withdrawn and the claims allowed.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claim 3

The Office Action rejects claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection where not rendered moot by amendment.

For at least the reason that independent claim 1 is allowable over the cited references of record, dependent claim 3 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that dependent claim 3 contains all the features of independent claim 1. Therefore, the rejection to claim 3 should be withdrawn and the claim allowed.

B. Claim 30

The Office Action rejects claim 30 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection where not rendered moot by amendment.

Independent claim 30, as amended, recites:

30. A method of manipulating email messages with an email network appliance comprising:
receiving an email message with an email network appliance that can only provide the text of a message, ***the email message having had a determination made as to whether an attachment is text only and having had all attachments that are determined not to be text only automatically deleted such that the email message is text only;***
classifying the text only email message;
inserting the text only email message into a classification container;
presenting the classification container in a classification display section comprising at least two sections, each section containing one classification container;
presenting a text only email message in a classification container, wherein all presenting of the text only email message is performed off-line and prompting a user to save a sent email message;
wherein the email network appliance comprises a handheld email Internet appliance connected to a public switched network via an RJ-11 interface, the appliance further comprising a keyboard and a scrollable line display capable of presenting at least six lines but no more than fifteen lines.
(Emphasis added).

Applicant respectfully submits that claim 30 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that the amendments to claim 30 have rendered the rejection moot. Applicant respectfully submits that independent claim 30 is allowable for at least the reason that *Tsai* does not disclose, teach, or suggest at least **the email message having had a determination made as to whether an attachment is text only and having had all attachments that are determined not to be text only**

automatically deleted such that the email message is text only. Even if, assuming for the sake of argument, *Tsai* teaches removal of attachments from the email message, it fails to teach determining whether the attachment is text only and automatically deleting all attachments that are determined not to be text only. In *Tsai*, an attachment may be removed for later access by the receiving device, but no determination is made as to whether the attachment is text only. “[R]ecipients of emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure.” See *Tsai*, col. 3, lines 12-14. In the instant claim, the user is only able to view text only emails. The system disclosed in *Tsai* has no such limitation. As the cited reference does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 30, the rejection should be withdrawn for at least that reason.

V. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-9 and 20-30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

/BAB/

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